

RESPONSE TO OFFICE ACTION
DATED JANUARY 4, 2007

Appln. No. 10/792,353

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REMARKS

This is in response to the Office Action dated January 4, 2007. Reconsideration is respectfully requested.

Priority under 35 USC 119

The Examiner has indicated that only "some" of the certified copies of the priority documents have been received. The Examiner has not, however, identified the perceived deficiency in sufficient detail for the applicants to be responsive. Furthermore, our records show that the priority document was filed with the application, referenced in the Application Data Sheet and acknowledged as received by the Patent Office as evidenced by the itemized return postcard (attached). Applicants request that the Examiner advise their attorney if more information is required, and applicants will gladly supply whatever is missing.

Status of Claims

Claims 17-45 are pending. Applicants acknowledge, with appreciation, that Claims 30-37 would be allowable if rewritten in independent form to include the recitations of their respective base claims and any intervening claims upon which they depend.

Summary of Claim Objections

Various claims are objected to due to a typographical error regarding the dependency of Claim 19 on non-existent Claim 1. As correctly assumed by the Examiner, Claim 19 should depend upon Claim 17 and has been so amended.

Summary of Objections to the Description

Applicants have corrected the minor typographical errors on page 3 of the application and in Claims 41-43 identified by the Examiner.

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Summary of Rejections under 35 USC 112

Claims 17-45 are rejected as indefinite, the Examiner contending that there is insufficient support in the description for the recitation of "worm gear" in Claim 17. The Examiner is correct in his assumption that the "worm gear" recited corresponds to the item 44, identified in the description as a "screw". Applicants have amended the various claims to recite "screw" instead of "worm gear", thereby rendering the rejections as to indefiniteness moot.

Applicants have further amended Claims 30-34 to remove a reference to the "intermediate toothed wheel" after the introduction of the first and second partial toothed wheels, since the intermediate toothed wheel is comprised of the first and second partial toothed wheels. In Claims 41-43, the term "reciprocably" has been amended to "reciprocally".

Summary of the Substantive Rejections

Claims 17-20 are rejected as obvious over U.S. Patent No. 3,597,187 to Trudeau, in view of U.S. Patent No. 5,832,780 to Gallienne. Claims 18-22 are rejected as obvious over Trudeau and Gallienne, in view of European Patent Application 0 133 775 to Fenton. Claims 23-27 are rejected as obvious over Trudeau, Gallienne, Fenton and further in view of U.S. Patent No. 4,793,847 to Kawachi et al. Claims 28 and 29 are rejected as obvious over Trudeau, Gallienne, Fenton Kawachi et al and further in view of U.S. Patent No. 6,318,130 to Bennett. Claims 38-40 are rejected as obvious over Trudeau, Gallienne and Fenton. Claims 41-43 are rejected as obvious over Trudeau, Gallienne, Fenton and further in view of U.S. Patent No. 5,824,129 to Struckmeier et al. Claims 44 and 45 are rejected as obvious over Trudeau, Gallienne, Fenton and Struckmeier et al.

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The Argument

Applicants respectfully traverse the rejections on the basis of obviousness, contending that the cited references fail to meet the requirements necessary to establish a *prima facie* case of obviousness. This is demonstrated on a claim-by-claim basis in the arguments presented below.

Claim 17

Two of the three criteria necessary to establish a *prima facie* case of obviousness require that the prior art references must teach or suggest all claim limitations, and there must be some suggestion or motivation to modify or combine the reference teachings. The cited references Trudeau and Gallienne fail to meet these requirements for Claim 17, i.e., there is no motivation to combine these references, and even when they are combined, all claim elements are not taught or suggested.

Claim 17 recites, in relevant part:

"a gear train transmitting torque from said motor to said pinion, said gear train including a screw engaged with said motor, said motor being adapted to rotate said screw in a reciprocating manner, a worm wheel engaged with said screw and rotatable in response to rotation of said screw, a toothed wheel mounted coaxially with said worm wheel and fixed thereto so as to rotate with said worm wheel, said toothed wheel driving said pinion for effecting rotation of said scoop channel upon rotation of said screw by said motor."

One would not be motivated to modify Trudeau by mounting a toothed wheel coaxially with the worm wheel 38 (see Figure 2) as suggested by the Examiner because it would render Trudeau unsatisfactory for its intended purpose. Claim 17 recites that the toothed wheel drives the pinion for effecting rotation of the scoop channels. Thus, for the proposed

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modification to teach this claim element, the toothed wheel would be mounted coaxially with worm wheel 38 and would also have to engage pinions 27 which rotate the scoop channels 18. This would, however, eliminate the carrier disk 36 and its cam 35, which is necessary to rotate the scoop channels in the proper directions and through the appropriate angles to distribute gobs in the specific pattern as described at column 3, line 38 and shown graphically in Figure 5. If Trudeau is modified by the addition of a toothed wheel that is coaxial with the worm wheel and which engages the pinions as recited in Claim 17, then no provision is made for reciprocal motion of the scoop channels and the proper distribution of the gobs as described in Trudeau. Trudeau, modified as suggested by the Examiner, would, therefore, be unsatisfactory for its intended purpose, as it would not function properly because it would not reciprocate as required for the desired gob distribution. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). See also MPEP, Section 2143.01.

Additionally, the proposed modification does not result in an apparatus which teaches or suggests every claim element. Claim 17 recites an electric motor for rotating the pinion and thereby rotating the scoop channel, the motor being adapted to rotate the screw in a reciprocating manner. There is no such teaching in either Trudeau or Gallienne of such a motor. Trudeau teaches a carrier disk 36 having a cam 35 which is engaged by rollers 33 on sector gears 28 and 28 to provide reciprocating motion of the scoop channels 18. Gallienne makes no provision whatsoever for reciprocal motion, let alone a motor controlled to produce reciprocal motion. To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all claim elements. Clearly, the

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combination of Trudeau and Gallienne fail to meet this requirement.

Claim 18

Claim 18 depends upon Claim 17 and should be allowable for the same reasons that Claim 17 is allowable over Trudeau and Gallienne. The Examiner has also cited Fenton for the recitation of an intermediate toothed wheel to drive the pinions. However, the Examiner has not given any reason why one would substitute the direct driving of pinions with an intermediate toothed wheel. The mere fact that such a configuration is disclosed in a reference is not enough to provide the motivation or suggestion necessary to establish a *prima facie* case of obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). See also MPEP, Section 2143.01. It appears that in citing Fenton, the Examiner has used the applicants' teaching in an impermissible hindsight reconstruction of applicants' invention, as there is no rationale given by the Examiner as to why one would modify Trudeau as suggested. The cited references Trudeau, Gallienne and Fenton do not meet the requirements necessary to establish a *prima facie* case of obviousness and cannot properly support a rejection of Claim 18 on this basis.

Claims 19-22 depend, either directly or indirectly, upon Claim 17 and should be allowable for the same reasons that Claim 17 is allowable. Furthermore, the arguments provided above for Claim 18 apply equally well to Claims 19-22. Applicants also note that Claim 22 recites that each of the intermediate toothed wheels engages two pinions. This is not taught in Fenton or any of the other cited references. Again, the requirements necessary to establish a *prima facie* case of

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obviousness are not met, because all claim recitations are not taught or suggested by the cited references.

Claims 23-27

Claims 23-27 are rejected as obvious over Trudeau, Gallienne and Fenton and further in view of Kawachi et al. These claims depend, either directly or indirectly, on Claim 17 and should be allowable for the same reasons that Claim 17 is allowable as explained in the arguments presented above. Additionally, the Examiner has not explained why one would be motivated to modify Trudeau as taught by Kawachi et al. As explained above, it is not enough that references can be combined, there must be some motivation. Furthermore, the Examiner requires four references which, even when combined, do not teach or suggest all claim limitations. As the number of references grow, it becomes more and more clear that the Examiner is using the prior art as a catalog, picking and choosing parts from disparate mechanism as needed in a hindsight reconstruction of applicants' invention without serious thought as to why one of ordinary skill in the art would so totally redesign Trudeau, which is a functioning device.

Claims 28 and 29

Claims 28 and 29 depend indirectly on Claim 17 and should be allowable over the cited references for the same reasons that Claim 17 is allowable. Furthermore, the Examiner has failed to identify where those features recited in Claims 28 and 29 are to be found in the Bennett reference. Claim 28 recites an outer sleeve mounted on a housing, and a connection sleeve rotatably mounted coaxially within said outer sleeve. Applicants request that the Examiner point out where in a reference such as Bennett, which teaches fixed scoop channels (see column 3, lines 8-14), provision is made for rotation of the scoop channels as recited in Claims 28 and 29, which recite "a connection sleeve rotatably mounted coaxially with

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said outer sleeve". In fact, the Bennett reference has only slight applicability to the claims of the instant case, and merely teaches a way of cooling components of a glass forming device, but fails to teach or suggest the recitations of the claims as required to establish a *prima facie* case of obviousness.

Claims 41-45


Claims 41-43 depend, either directly or indirectly, upon Claim 17 and should be allowable for the same reasons that Claim 17 is allowable.

Summary

Applicants have demonstrated in the arguments presented above that the cited references fail to meet the requirements necessary to establish a *prima facie* case of obviousness because there is no motivation to combine the references and modify them, and even when they are combined the combination still fails to teach or suggest all claim recitations. Applicants contend that, with the amendments to the specification provided herein, the application is in condition for allowance and request that it be passed to issue.

Respectfully submitted,

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Inventor / TM. Appl. <u>H Hermening et al.</u>	Appl. No. _____	Filing Date <u>Herewith</u>
Client <u>Sobisch & Callies</u>	Docket No. <u>27593 USA</u>	Atty. <u>GAH/pmf</u>
Title of Invention / Mark <u>Gap Distributor</u>		

The Patent / Trademark Office is in receipt of the following:

<input type="checkbox"/> Affidavit/Declaration, 37 CFR _____	<input type="checkbox"/> PCT Application, transmittal, request & fee sheet
<input type="checkbox"/> Amendment, 37 CFR _____	<input type="checkbox"/> Petition under 37 CFR
<input type="checkbox"/> Amendment to allege use	<input type="checkbox"/> Petition for cancellation
<input type="checkbox"/> Appeal notice/Appeal brief	<input type="checkbox"/> Power of attorney
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<input checked="" type="checkbox"/> Assignment & cover sheet	<input type="checkbox"/> Renewal application
<input type="checkbox"/> Cert. of correction request	<input type="checkbox"/> Reply, 37 CFR _____
<input checked="" type="checkbox"/> Cert. of Exp. Mailing, Date <u>3-3-04</u>	<input type="checkbox"/> Request for extension of time to file opposition notice
No. <u>EV 3752 88544 US</u>	(in triplicate)
<input type="checkbox"/> Cert. of mailing, Dated _____	<input type="checkbox"/> Section 8/Section 15 Affidavit/Declaration
<input type="checkbox"/> Charge deposit account, in duplicate	<input type="checkbox"/> Specimens _____
<input checked="" type="checkbox"/> Check \$ <u>810-</u> for <u>filing fee</u>	<input type="checkbox"/> Statement of use
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Applv - Data Sheet
Prelim. Amend